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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,825	09/04/2003	Wayne J. Falcon	34321.3	5170
27683	7590	08/26/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			ALIMENTI, SUSAN C	
			ART UNIT	PAPER NUMBER

3644

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,825

Applicant(s)

FALCON, WAYNE J.

Examiner

Susan C. Alimenti

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 9, 12, 16, 19, 24, 29-32, 37, 38, 41, 44, 49, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, 10, 11, 13-15, 17, 18, 21-23, 25-28, 33-36, 39, 40, 42, 43, 45-48, 50-54 and 57-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 5-6, 9, 12, 16, 19, 24, 29-32, 37-38, 41, 44, 49, and 55-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 28 July 2004.

2. Applicant's election with traverse of species 3 in the reply filed on 28 July 2004 is acknowledged. The traversal is on the grounds that the examiner did not set forth proper grounds for restriction and applicant cited MPEP § 816. This is not found persuasive because the applicant has brought attention to an MPEP section that deals with a group restriction requirement wherein independent inventions have been identified. This is not the case. The examiner refers applicant to MPEP § 809.02(a), pertaining to the election of species/embodiments of a single invention, and maintains the restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3644

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 7, 8, 10, 11, 13-15, 17, 18, 21-23, 25-28, 33-36, 39, 40, 42, 43, 45-48, 50-54 and 57-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10655,446. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is the change in size of the weight disposed on the fish hook and it has been held that there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. Eskimo Pie Corp. v. Levous et al., 3 USPQ 23.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3644

7. Claims 1-4, 7-8, 10-11, 13-15, 17-18, 21-23, 25-28, 33-36, 40, 42-43, 45-48, 50-54, 57-71 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McClellan (US 5,220,743).

McClellan discloses a weighted fishhook comprising a straight shank 26 having a hook eye 27 at one end 28, and bend 30 and hook tip 32 at the opposite end (McClellan, Figures 4-9). The hook tip 32 has a spaced barb and terminates in a reverse bend 29, relative to bend 30. A double-tapered weight 10 (Figure 1 & 4) is centrally located on said hook shank and is interchangeable with the two hook embodiments as taught by McClellan. The shank 26 is substantially straight from above said bend 30 to at least above said top weight taper 24 (Figure 6). The shank 26 further comprises an offset bend 20 (Figure 4) between said weight 10 and said hook eye.

A lure 21 is also shown as usable with the fishhook wherein the hook tip, barb, reverse bend and hook eye are *at least partially* embedded in said lure 21. Further the reverse bend and said barb extend alongside said lure.

Regarding claim 67, McClellan's fishhook comprises a shank offset bend 20 and further comprises a shank offset 23, a shank neck bend defined as the bend at the end of the shank offset that begins to create hook eye 27, and a shank neck 16.

Regarding claim 68, McClellan does not expressly show the shank offset bend 20, shank offset 23, shank neck bend as being embedded in said lure 21, however this would only require a minor adjustment of the lure, which is generally required during the fishing process. It would have been obvious to one having ordinary skill in the art at the time the invention was made to position said lure in a variety of ways, since this is a well-known practice in the art.

Art Unit: 3644


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan C. Alimenti whose telephone number is 703-306-0360. The examiner can normally be reached on Monday-Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Carone can be reached on 703-306-4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCA


TERI PHAM LUU
PRIMARY EXAMINER